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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,510	03/13/2001	Hans-Peter Weitzel	U-Wp-5577 Wacker	1883

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EXAMINER

REDDICK, MARIE L

ART UNIT

PAPER NUMBER

1713

10

DATE MAILED: 11/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

TC-10

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/805,510		WEITZEL, HANS-PETER	
	<b>Examiner</b>		<b>Art Unit</b>	
	Judy M. Reddick		1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 September 2002.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

**Claim Rejections - 35 USC § 112**

1. **The following is a quotation of the second paragraph of 35 U.S.C. 112:**
  - a. **The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.**
2. **Claims 21-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**
3. **The recited "cement-free type" per claim 21 constitutes indefinite subject matter as per it not being readily apparent as to if or how said objectionable term "type" further limits the claims, i.e., when appended to an otherwise definite expression, "type" so extends the scope of the expression as to render it indefinite (Ex parte Copenhaver, 109 USPQ 118).**
4. **The recited "wherein at least one auxiliary monomer is selected from the group----" per claims 23 and 24 and "wherein said monomers further comprise at least one further monomer" per claim 25 constitutes indefinite subject matter as per said phrases engender awkwardly expressed claim language. The following language is suggested: "----wherein said auxiliary monomer is at least one selected from the group consisting of----"(claims 23 and 24); "----wherein said monomers further comprise at least one monomer or monomer mixture selected from the group consisting of----"(claim 25).**
5. **In claim 39, line 1, it is suggested that "the" be inserted before "at least one" so as to engender claim language clarity.**

**Claim Rejections - 35 USC § 102**

6. **The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**
  - b. **A person shall be entitled to a patent unless –**
  - c. **(e) the invention was described in-**
    - (1) **an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty**

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**defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or**

**(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).**

**7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

**(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.**

**8. Claims 21-40 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Schilling et al as per reasons stated in the previous Office Action per paper no. 8, 05/03/02, paragraph no. 12, as applied to claims 1-20. Further, Schilling et al disclose that additives such as cements and other inorganic materials can be added to the wood-bonding, water-redispersible polymer powder adhesive compositional formulations so as to enhance the storage properties and, for all practical purposes, this translates to a cementitious-based adhesive, as claimed(see col. 5, lines 31-45 and Run 5). As to the recited "A process for improving the tensile strength of a set cementitious or cement-free, inorganic binder-based construction adhesive" per claim 37, while the reference does not show a specific recognition of this result, its discovery by applicant is tantamount only to finding a new property for an old composition(In re Tomlinson, 363 F.2d 928, 150 USPQ 623(CCPA 1966)).**

**Even if it turns out that the Examiner has somehow missed the boat and Schilling does not anticipate the claimed invention, it would have been obvious to the skilled artisan to use the aforementioned water-redispersible polymer powder adhesive formulations of Schilling et al in the admittedly old prior art system, based on the structurally paralleling similarities of the admittedly old composition and the composition of Schilling et al, and**

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*with a reasonable expectation of success and with the understanding that the claim preamble is in Japanese format which translates to an implied admission of prior art, as supported in the specification on page 1 under "Background Of The Invention".*

**Claim Rejections - 35 USC § 102**

9. *Claims 21-40 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Geissler as per reasons stated in the previous Office action per paper no. 8, 05/03/02, paragraph no. 15, as applied to claims 1-20.*

*As to the recited "A process for improving the tensile strength of a set cementitious or cement-free, inorganic binder-based construction adhesive" per claim 37, while the reference does not show a specific recognition of this result, its discovery by applicant is tantamount only to finding a new property for an old composition(In re Tomlinson, 363 F.2d 928, 150 USPQ 623(CCPA 1966)).*

**Response to Arguments**

10. *Applicant's arguments filed 09/04/02 have been fully considered but they are not persuasive.*

Relative to Schilling et al—*The crux of Counsel's arguments appears to hinge on the content of auxiliary monomers recited in the Runs of Schilling et al being in excess of the claimed "0.2 to 1.5 wt.%". Counsel is cordially reminded that a reference is evaluated, as a whole, for what it fairly teaches and is in no way limited to the working examples. To this end, Schilling et al, at col. 3, lines 19+, teach at little as 0.05 wt.% of auxiliary monomer overlapping in scope of the claimed auxiliary monomer.*

Relative to Geissler—*The crux of Counsel's arguments appear to hinge on there being no single Example that houses a polymer falling within the scope of the claimed invention, i.e., no motivation to extrapolate a hydrophilic monomer unit-governed vinyl acetate polymer wherein the hydrophilic monomer unit is governed by a content in the range of*

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**0.2 to 1.5 wt.%, as claimed. Again, Counsel is reminded that a reference is evaluated, as a whole, for what it fairly teaches and is in no way limited to the working Runs, i.e., the specification need not contain an example if the invention is otherwise disclosed in a manner that one skilled in the art would be able to practice it without an undue amount of experimentation. To this end, the disclosure clearly teaches the use of up to 5 wt.%, in particular, 0.1 to 5 wt.%, of hydrophilic monomer falling within the scope of the claimed invention in formulating the water-redispersible polymer powder(see the col. bridging cols. 2-3).**

#### **Conclusion**

**The additional prior art made of record and not relied upon is cited of interest in teaching similar water-redispersible vinyl acetate polymer powders, as claimed and is considered merely cumulative to the prior art supra. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..**

**11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).**

**A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.**

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*If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.*

*Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.*

*J. M. Reddick*  
Judy M. Reddick  
Primary Examiner  
Art Unit 1713

JMR *JMR*  
November 14, 2002